

### **REMARKS**

The Office Action mailed October 13, 2005 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

#### **I. Claim Summary**

Claims 45-88 are currently pending in the application, with claims 45, 56, 65, 75, and 80 being independent claims. Claims 1-44 are cancelled and claims 45-88 are added, in accordance with the above amendments.

#### **II. Office Action Summary**

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claim 39 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 6,140,602 to Costin; and
- Claims 12-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Costin and PCT International Publication Number WO 00/46045 to Gray.

The Office Action also objected to claims 31-35 under 35 U.S.C. §112, second paragraph, as being indefinite. The Applicant respectfully traverse this objection and note that this objection is moot given that claims 31-35 have been cancelled.

#### **III. Discussion of Applied References**

The Office Action rejected various claims over the combination of Costin and Gray. Although claims rejected over the combination of Costin and Gray are cancelled, the following material will discuss claims 45-88 in relation to Costin and Gray.

##### *Discussion of Costin*

Costin discloses marking of fabrics and other materials with a laser to impart various designs. More particularly, Costin discloses the use of a laser beam to slightly penetrate the surface of a material at a controlled speed that is within a predetermined range. The laser beam

is directed at the material either directly or through mirrors, shutters, or lenses, and a computer may be used to provide a signal to a drive mechanism to control the relative speed. According to Costin, the "designs can be single or multiple color, full or partial penetrating, relief or flat, or combinations thereof" (Costin, column 5, lines 57-59). In addition, the invention can "be used to impart significant design patterns onto car leather interiors, jackets, boots, purses and wallets which are typically only differentiated by color" (Costin, column 6, lines 1-4).

#### *Discussion of Gray*

Gray discloses a method for forming a design in a layered panel. The method includes providing an outer layer on an inner layer to form a single composite panel including the two layers. The design is developed by forming voids in the outer layer by exposing regions of the outer layer to a laser beam that burns, vaporizes, or otherwise removes portions of the outer layer in each exposed region. In addition, the voids create the design by exposing the inner layer. According to Gray, the "two layers...comprise respective first and second materials of different appearance, preferably plastic materials. The difference in appearance between the respective first and second plastic materials may be due to differences in any one of a number of different visually discernible attributes including but not limited to color, intensity, texture, pattern, gloss, and thickness" (Gray, page 4, lines 2-7).

#### **IV. Discussion of Claims 45-55**

##### *Independent Claim 45*

Independent claim 45 recites a method for manufacturing an article of footwear. The method includes providing a stratified material having a first layer and a second layer that are secured together. An incision is formed in the stratified material with a laser. The incision extends through the first layer to expose the second layer, and the incision segregates a first area of the first layer from a second area of the first layer. The first area of the first layer is removed by separating the first area of the first layer from the second layer. In addition, the stratified material is incorporated into an upper of the article of footwear.

Costin and Gray both disclose the concept of utilizing a laser to form a pattern on a material. In contrast with independent claim 45, however, neither Costin nor Gray teach or suggest the combination of (a) forming an incision that segregates a first area of the first layer

from a second area of the first layer and (b) removing the first area of the first layer by separating the first area of the first layer from the second layer.

An example of this combination of steps is disclosed in the application at Figures 12 and 13. With reference to Figure 12, the laser forms an incision to define a first area (i.e., the circular portion) and a second area (i.e., the rectangular portion around the circular portion). In effect, the incision segregates the first area from the second area. Following formation of the incision, the first area is removed, as depicted in Figure 13. Another example of this combination of steps is disclosed in the application at Figures 16 and 17.

With reference to Costin and Gray, the concept of forming incisions in the materials is disclosed in various figures, but neither Costin nor Gray disclose both (a) segregating an area and (b) removing that area.

#### *Dependent Claims 47-50*

Costin and Gray disclose forming designs with a laser in order to modify the appearance of materials. For example, Costin states that the invention can "be used to impart significant design patterns...which are typically only differentiated by color" (Costin, column 6, lines 1-4). Similarly, Gray states that the "two layers...comprise respective first and second materials of different appearance....The difference in appearance...may be due to differences in any one of a number of different visually discernible attributes including but not limited to color, intensity, texture, pattern, gloss, and thickness" (Gray, page 4, lines 2-7). Accordingly, Costin and Gray teach that the laser process modifies visual aspects of the materials. In contrast, claims 47-50 recite that the layers are selected based upon different properties that include abrasion-resistance, air-permeability, flexibility, and stretch-resistance. The concept of selecting materials based upon these features is not taught or suggested by Costin and Gray.

#### *Dependent claim 55*

Dependent claim 55 recites a step of applying heat and pressure to the stratified material to bond the layers together, and this step is performed following the step of removing the first area of the first layer. In the Office Action, the Examiner states that applying heat and pressure to bond layers together is conventional in the art. In combination, claims 45 and 55 recite the following: (a) forming an incision that segregates a first area of the first layer from a second area

of the first layer, (b) removing the first area of the first layer by separating the first area of the first layer from the second layer, and (c) applying heat and pressure to the stratified material to bond the layers together. While applying heat and pressure may be known, this combination and order of steps is neither taught nor suggested by Costin and Gray.

Based upon the above discussion, the Applicant respectfully submits that independent claim 45 is allowable over the combination of Costin and Gray. In addition, dependent claims 46-55 should be allowable for at least the same reasons, and for the additional reasons specifically discussed above.

#### **V. Discussion of Claims 56-64**

Independent claim 56 recites a method for manufacturing an article of footwear. The method includes providing a stratified material having at least two layers that are secured together. The layers include a first layer and a second layer with different properties, which are at least one of abrasion-resistance, air-permeability, flexibility, and stretch-resistance. An incision is formed in the stratified material with a laser, and the incision extends through the first layer to expose the second layer. In addition, the stratified material is incorporated into an upper of the article of footwear.

As discussed with respect to claims 47-50, Costin and Gray disclose forming designs with a laser in order to modify the appearance of materials. For example, Costin states that the invention can "be used to impart significant design patterns...which are typically only differentiated by color" (Costin, column 6, lines 1-4). Similarly, Gray states that the "two layers...comprise respective first and second materials of different appearance....The difference in appearance...may be due to differences in any one of a number of different visually discernible attributes including but not limited to color, intensity, texture, pattern, gloss, and thickness" (Gray, page 4, lines 2-7). Accordingly, Costin and Gray teach that the laser process modifies visual aspects of the materials. In contrast, independent claim 56 recites that the different properties of the layers are at least one of abrasion-resistance, air-permeability, flexibility, and stretch-resistance. Utilizing materials with these different properties is not taught or suggested by Costin and Gray.

Based upon the above discussion, the Applicant respectfully submits that independent claim 56 is allowable over the combination of Costin and Gray. In addition, dependent claims 57-64 should be allowable for at least the same reasons.

#### **VI. Discussion of Claims 65-74**

Independent claim 65 recites a method for manufacturing an article of footwear. The method includes providing a stratified material having a first layer and a second layer that are non-permanently secured together. An incision is formed in the stratified material with a laser. The incision extends through the first layer to expose the second layer, and the incision segregates a first area of the first layer from a second area of the first layer. The first area of the first layer is removed by separating the first area of the first layer from the second layer. The first layer and the second layer are permanently secured together following removal of the first area. In addition, the stratified material is incorporated into an upper of the article of footwear.

Costin does not disclose using a stratified material. Gray discloses using a layered material, but is effectively silent as to the manner in which the layers are joined to each other. Gray does state, however, that the layers may be formed separately and then bonded together, or the layers may be manufactured as a single composition (Gray, page 4, lines 24-26). In contrast, independent claim 65 recites that the layers are non-permanently secured together in the step of providing the stratified material, and independent claim 65 recites permanently securing the layers together following removal of the first area. Accordingly, independent claim 65 recites a non-permanent securing prior to forming the incision and removing the first area, and independent claim 65 recites permanently securing the layers together following removal of the first area. Neither Costin nor Gray teach or suggest this method.

Based upon the above discussion, the Applicant respectfully submits that independent claim 65 is allowable over the combination of Costin and Gray. In addition, dependent claims 66-74 should be allowable for at least the same reasons.

#### **VII. Discussion of Claims 75-79**

Independent claim 75 recites a method for manufacturing an article of footwear. The method includes providing a stratified material having a first layer, a second layer, and a third layer that are secured together, the second layer being positioned between the first layer and the

second layer. A first incision is formed in one side of the stratified material with a laser. The first incision extends through the first layer to expose the second layer. A second incision is formed in an opposite side of the stratified material. The second incision extends through the third layer to expose the second layer. In addition, the stratified material is incorporated into an upper of the article of footwear.

Both Costin and Gray disclose forming patterns on one side of a material with a laser. Neither reference, however, teaches or suggests forming patterns on both sides, particularly in a three layer configuration. In contrast, independent claim 75 recites a first incision formed in one side, and a second incision formed in an opposite side.

Based upon the above discussion, the Applicant respectfully submits that independent claim 75 is allowable over the combination of Costin and Gray. In addition, dependent claims 76-79 should be allowable for at least the same reasons.

#### **VIII. Discussion of Claims 80-88**

Independent claim 80 recites a method for manufacturing an article of footwear. The method includes providing a stratified material having a first layer, a second layer, and a third layer that are secured together, the second layer being positioned between the first layer and the third layer. A first incision is formed in the stratified material with a laser. The first incision extends through the first layer to expose the second layer, and the first incision segregates an area of the first layer from a remainder of the first layer. The area of the first layer is removed by separating the area of the first layer from a portion of the second layer. A second incision is formed in the stratified material. The second incision extends through the portion of the second layer to expose the third layer, and the second incision segregates an area of the second layer from a remainder of the second layer. The area of the second layer is removed by separating the area of the second layer from a portion of the third layer. In addition, the stratified material is incorporated into an upper of the article of footwear.

Neither Costin nor Gray disclose a three layer configuration wherein a first incision removes an area of the first layer, and a second incision removes an area of the second layer in the manner recited by independent claim 80. An example of the process recited by independent claim 78 is depicted in the application at Figures 12-15. With reference to Figure 12, the laser forms an incision to define a first area (i.e., the circular portion) and a second area (i.e., the

rectangular portion around the circular portion). In effect, the incision segregates the first area from the second area. Following formation of the incision, the first area is removed, as depicted in Figure 13. Another incision is then formed in a portion of the second layer that previously was covered by the first layer, as in Figure 14, and an area of the second layer is removed, as in Figure 15. With reference to Costin and Gray, the concept of forming incisions in the materials is disclosed in various figures, but neither Costin nor Gray disclose both (a) segregating an area of the first layer, (b) removing that area of the first layer, (c) segregating a portion of an underlying second layer, and (d) removing that area of the second layer.

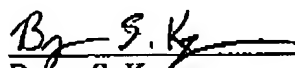
Based upon the above discussion, the Applicant respectfully submits that independent claim 80 is allowable over the combination of Costin and Gray. In addition, dependent claims 81-88 should be allowable for at least the same reasons.

#### **IX. Conclusion**

In view of the foregoing, the Applicant respectfully submits that all claims are in a condition for allowance. The Applicant respectfully requests, therefore, that the rejections be withdrawn and that this application now be allowed.

This Amendment is being timely filed by facsimile transmission on February 10, 2006 with a one month Petition for Extension of Time. Should additional fees or an additional extension of time be deemed necessary for consideration of this Amendment, such fees or extension are hereby requested and the Commissioner is authorized to charge deposit account number 19-0733 for payment. If anything further is desirable to place the application in even better form for allowance, the Examiner is respectfully requested to telephone the undersigned representative at (503) 425-6800.

Respectfully submitted,

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